Supreme Court, U.S.
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No. 95-996

In The
SUPREME COURT OF THE UNITED STATES
October Term, 1995

JAMES J. MALOT,

Petitioner,

v.

ROY F. WESTON, INC., and WESTON SERVICES, INC.,

Respondents.

On Petition For A Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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27 pp

QUESTION PRESENTED

Petitioner's "Questions Presented" are argumentative and raise policy questions concerning the federal judiciary that are wholly unrelated to the merits of the parties' dispute. Respondents submit that Petitioner's request for review properly presents a single issue: Whether the District Court and Court of Appeals correctly concluded that Respondents were entitled to judgment as a matter of law that Claim 8 of the patent in suit was invalid and not infringed.

LIST OF PARTIES

The parties are correctly identified in the style of the Petition and of this response.

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STATEMENT OF THE CASE

The courts below entered and upheld summary judgment in Respondents' favor not, as Petitioner suggests, because this case is complex, but instead because it is simple.

Petitioner's allegations before the District Court were narrow: That Respondents had literally infringed a single claim ("Claim 8") of Petitioner's patent through Respondents' removal of liquid organic contaminants from a single site. Respondents' defenses were equally narrow: (1) Petitioner's patent was invalid under 35 U.S.C. § 102 because of anticipatory prior art encompassing Petitioner's claim; (2) Petitioner's claim was "obvious" under 35 U.S.C. § 103; and (3) Even if Petitioner's claim was not invalid, the technology employed by Respondents in the single site clean up did not infringe that claim.

Based on undisputed testimony and documentary evidence, and following full briefings and hearings, both the District Court and the Court of Appeals concluded that Respondents were entitled to judgment as a matter of law because (1) Petitioner's Claim 8 was invalid; *and* (2) even if valid, Claim 8 was not infringed by Respondents' process. Because these holdings applied well-settled principles of law supported by undisputed evidence and testimony, the Court of Appeals determined that Petitioner's arguments were so lacking in merit that they did not warrant extended analysis.

SUMMARY OF THE ARGUMENT

The Court should deny review because the Petition presents no issue warranting this Court's attention. Petitioner cannot demonstrate an intercircuit conflict bearing on the parties' dispute or that the decision of the Court of Appeals is inconsistent with that of a state court of last resort. Petitioner cannot demonstrate that the District Court and the Court of Appeals erred in their resolution of an important federal question. And Petitioner cannot demonstrate that this case presents issues of constitutional magnitude.

Rather, Petitioner merely disagrees with the determinations of the courts below that no material factual disputes precluded entry of summary judgment in Respondents' favor. Because the District Court and the Court of Appeals properly resolved this question, and because this case otherwise involves the application of well-established legal principles, summary disposition and summary affirmance were appropriate.

ARGUMENT

I. PETITIONER SEEKS TO ADD TO THE OVER-BURDENED DOCKETS OF THE FEDERAL APPELLATE COURTS

This Court should reject Petitioner's suggestion that there is no place in federal practice for the summary disposition of cases presenting neither novel legal issues nor disputed material facts. Respondents agree with Petitioner that the federal appellate courts are burdened with overwhelming dockets. In 1960, under 4,000 appeals were taken to the United States Courts of Appeals. *Annual Report of the Director of the Administrative Office of the United States Courts* 210 (1960). By 1990, this figure had risen to over 30,000 appeals annually. *Annual Report of the Director of the Administrative Office of the United States Courts* I-3 (1990).[1]

The parties disagree, however, on the appropriate response to the problem of crowded dockets. Petitioner's arguments turn on the unlikely proposition that it is in the interest of judicial economy for federal appellate courts to produce a comprehensive opinion in every case before them, regardless of the underlying lack of merit of the appeal. Petitioner also suggests that this Court should impose upon the Courts of Appeals a requirement that those courts retain appeals under consideration for a set (but unspecified) period

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[1] Significantly, the United States Court of Appeals for the Federal Circuit, to which Petitioner seeks a Writ of Certiorari, consistently has demonstrated its leadership in dealing with the explosive growth of appellate dockets. *See* Hon. Paul R. Michel, *The Challenge Ahead: Increasing Predictability in Federal Circuit Jurisprudence for the Next Century*, 43 Am. L. Rev. 1231, 1232-33 & n.6 (1994).

of time, regardless of the actual time required to dispose of those appeals.

Respondents submit that just the opposite is appropriate. To give but one example, this Court has for decades recognized that a substantial portion of the petitions for certiorari presented to it do not present questions warranting extended attention. Likewise, the response of the Chief Judge of the Second Circuit to the *Wall Street Journal* editorial cited in the Petition contains what should be a self-evident point, namely that "[p]reparing full opinions on every appeal would significantly delay the decision of all appeals." Hon. Jon O. Newman, *No "Secret" Opinions on Appellate Courts*, *Wall Street Journal*, January 2, 1996, at A9. Thus, contrary to Petitioner's claims, it is the *cultivation*, rather than the *prohibition*, of summary affirmances such as that undertaken by the Court of Appeals in this case that will encourage the development of sound jurisprudence:

> [Curtailing published opinions] may be the last, best hope of the appellate judiciary. Opinion writing is far from an exact science, and good opinions, like well-made suits of clothes, are best when custom tailored. The work is labor intensive. Because published opinions require extra pains, reducing the number of published opinions will allow judges to devote more time and energy to the elucidation of important legal principles in cases that warrant great care and contemplative thought.

Hon. Bruce M. Selya, *Publish and Perish: The Fate of the Federal Appeals Judge in the Information Age*, 55 Ohio St. L. J. 405, 414 (1994).

Moreover, the proliferation of "law review" opinions such as that sought by Petitioner threatens the American

legal system in another manner independent of demands on court time to produce them:

> [U]nlimited proliferation of published opinions constitutes a burden and a threat to a cohesive body of law . . . . [T]here are limits on the capacity of judges and lawyers to produce, research and assimilate the sheer mass of judicial opinions. These limits are dangerously near at present and in some systems may already be exceeded . . . . Common law in the United States could be crushed by its own weight if present trends continue.

Charles W. Joinder, *Limiting Publication of Judicial Opinions*, 56 Judicature 195, 196 (1972).

Particularly are these principles true in cases such as this one that present undisputed facts and no novel legal questions. As Dean Pound observed without the benefit of today's explosive growth in appellate dockets:

> After reading upwards of fourteen hundred double-column pages of judicial opinions, carefully sifted from many thousands of pages in the National Reporter System, one is impelled to ask why paper, printer's ink, labor, and shelfroom should be devoted to the perpetuation of what for the largest part is avowedly but repetition of things long familiar and is too often merely elaborate elucidation of the obvious.

Quoted in Eugene M. Prince, *Law Books, Unlimited*, 484 A.B.A. J. 134, 134 (1962).

More to the point, Petitioner entirely overlooks the interest of parties such as the Respondents who, having been unjustly charged with infringement, are forced to engage in time-consuming and expensive litigation. As the Second Circuit has noted in the trademark infringement context,

"[w]hether a litigant is seeking to halt an alleged infringement or . . . seeking a declaration of noninfringement, it is entitled to have the infringement issue resolved promptly so that it may conduct its business affairs in accordance with the court's determination of its rights." *Goya Foods, Inc. v. Tropicana Prods., Inc.*, 846 F.2d 848, 854 (2d Cir. 1988). Having raised arguments on appeal that deserved no extended discussion, Petitioner should not directly benefit from the meritless nature of those claims by securing review by this Court.

II. PETITIONER'S ARGUMENTS IGNORE THE TEACHINGS OF THIS COURT ON THE STANDARD FOR ENTRY OF SUMMARY JUDGMENT

Petitioner's arguments are flatly contrary to this Court's holdings on the correct standard for entry of summary judgment. Under Rule 56, "a party opposing a properly supported motion for summary judgment 'may not rest upon the mere allegations or denials of his pleading, but . . . must set forth specific facts showing that there is a genuine issue for trial.'" *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247 (1986) (quoting *First National Bank of Arizona v. Cities Service Co.*, 391 U.S. 253, 288 (1968)). In particular, "bald assertions, absent any evidentiary base, are insufficient to create a material issue of fact . . . ." *Frederick S. Wylie P.C. v. Texaco, Inc.*, 764 F.2d 604, 612 (9th Cir. 1985).

Petitioner lost this case in the courts below because the uncontroverted evidence presented by Respondents showed that (1) every step of the Claim 8 process was known and publicly used in prior art processes not disclosed to the Patent and Trademark Office when it allowed Claim 8 and (2) Respondents' process accused of infringing Claim 8 was

exactly the same as the prior art processes. In response to Respondents' motion for summary judgment, Petitioner totally failed to make the evidentiary showing necessary to raise any genuine issue of material fact with respect to either patent invalidity or noninfringement. Instead, Petitioner merely relied upon his own declaration purporting to evaluate the evidence introduced by Respondents. The declaration, riddled with speculation, conclusions, and statements made on information and belief (A1367-1401), failed to satisfy the requirements that it be made on personal knowledge and that it set forth *facts* that would be admissible at trial. *See, e.g., Automatic Radio Mfg. Co. v. Hazeltine Research, Inc.*, 339 U.S. 827, 831 (1950) (affidavit made upon information and belief does not comply with Rule 56(e)), *overruled on other grounds, Lear, Inc. v. Adkins*, 395 U.S. 653, 664 (1969); *Townsend Eng. Co. v. HiTec Co.*, 829 F.2d 1086, 1089 (Fed. Cir. 1987) (patentee's "opinion about the meaning and application of various phrases and provisions of [its] claim . . . does not create factual disputes that preclude[] the grant of summary judgment"); *Cable Elec. Prod., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025 (Fed. Cir. 1985) (declaration offering an "interpretation" of undisputed factual evidence insufficient statement of allegedly conflicting facts showing genuine issue for trial). Both the District Court and the Court of Appeals concluded that the materials submitted by Petitioner were insufficient to raise any disputed issue of material fact and that the evidence of prior public use submitted by Respondents rendered Claim 8 of Petitioner's patent invalid as a matter of law.

Petitioner's latest arguments are insufficient to create a material issue of fact, whether in this Court or in the courts below. At heart, Petitioner's claims are nothing more than vitriolic attacks on the credibility of Respondents' witnesses, whom Petitioner cavalierly asserts are, *inter alia*, "inherently unbelievable," unable to resist "the temptation to actual

perjury," and to be "regarded with skepticism." Petitioner's conclusory allegations, however, cannot obscure the complete absence of evidence supporting his claims of supposedly perjured testimony. Nor, as the Court of Appeals accurately noted, can they obscure the corroboration of that testimony *by Petitioner's own coinventor*. (Transcript of Oral Argument at 8-10, 12-13) Because "[a] motion for summary judgment cannot be defeated merely by an opposing party's incantation of lack of credibility over a movant's supporting affidavit," the Petition, like Petitioner's prior efforts, fails to create a material factual dispute. *See Walter v. Fiorenzo*, 840 F.2d 427, 434 (7th Cir. 1988); *see also Rinieri v. Scanlon*, 254 F. Supp. 469, 474 (S.D.N.Y. 1966) ("[T]he opposing party may not merely recite the incantation 'credibility' and have a trial on the hope that a jury may disbelieve factually uncontested proof.").

III. THE DISTRICT COURT AND THE COURT OF APPEALS CORRECTLY DETERMINED THAT NO MATERIAL FACTUAL DISPUTES PRECLUDED ENTRY OF SUMMARY JUDGMENT

The result in this litigation is not only correct, but routine. Even if this Court were to overlook the failure of the Petition itself to identify a legitimate issue of federal law warranting review, this case presents nothing more than the application of well-settled legal principles to undisputed facts. This Court therefore should deny the Petition because the record before the courts below establishes Respondents' entitlement to judgment as a matter of law.

A. As a Matter of Law, Claim 8 is Invalid Under 35 U.S.C. § 102 Because Anticipatory Prior Art Predated the Claim in Question

The courts below correctly determined that Petitioner's Claim 8 was invalid as anticipated by prior art. A patent claim is invalid under 35 U.S.C. § 102 if every element of the claim was practiced in a prior art invention or process. *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987). An element of a claimed invention may be disclosed by the prior art, even though that element is not expressly described, if the element is inherent in the reference. *Standard Havens Prods., Inc. v. Gencor Indus.*, 953 F.2d 1360, 1369 (Fed. Cir. 1991) ("An anticipatory reference, however, need not duplicate word for word what is in the claims. Anticipation can occur when a claimed invention is 'inherent' or otherwise implicit in the relevant reference."), *cert. denied*, 113 S. Ct. 60 (1992); *Verdegaal Bros.*, 814 F.2d at 631 (earlier invented process anticipates later claimed process even if the earlier inventor did not recognize one property of that process because that property was inherently possessed by the earlier process).

In entering summary judgment in Respondents' favor under 35 U.S.C. § 102, the District Court had before it declaration testimony from two individuals--Duane Knopik and Paul Yaniga--clearly establishing that that the process underlying Claim 8 was in use well prior to the Petitioner's putative date of invention. (A128-39; A351-59) Respondents also introduced evidence that Exxon Co. USA and Shell Oil Co. also had used the same technology well before Petitioner. (A188-193; A211-23; A1064-68) Finally, the District Court had the benefit of admissions *by Petitioner's*

coinventor that the claim was predated by Respondents' showing:

> Q: And does the description contained in Exhibit 5 of the process used by Soil Venting System describe the process covered by your patent.
>
> A: Very well, yes.
>
> Q: That is, the system described in Exhibit 5 in your view is the same as the system described in the patent?
>
> A: Yes.

(A 594: 6-12)

Unable even now to identify any evidence placing the evidence before the District Court into dispute, Petitioner relies on a distorted view of the law governing both anticipation and corroboration in attempting to discredit Respondents' evidence of prior art. As to anticipation, Petitioner invokes *Washington & Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U.S. 275 (1892), to suggest that the burden of proving invalidity is equivalent to the criminal law "beyond a reasonable doubt" standard. Petitioner fails to note, however, that subsequent decisions by this Court and others have long since abandoned the "reasonable doubt" rule and that a showing of clear and convincing evidence is the modern standard for anticipation. *See generally Trans-World Mfg. Corp. v. Al Nyman & Sons, Inc.*, 750 F.2d 1552, 1558-59 (Fed. Cir. 1984) (citing *Radio Corp. of Am. v. Radio Eng. Labs.*, 293 U.S. 1, 7-8 (1934); *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 60 (1923)). Of equal importance, Petitioner also fails to disclose that, even if it remains good law, *Washington & Moen* expressly limited its own scope to claims of anticipation supported only by oral testimony, circumstances that clearly are not present in this case. *See Washington & Moen*, 143 U.S. at 284-85.

As to corroboration, Petitioner stridently asserts that Respondent's overwhelming documentary evidence is entitled to no weight. When corroboration is required, however, a "rule of reason" analysis determines whether the testimony should be accepted. *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993). Under such an analysis, all pertinent evidence should be evaluated in determining whether the testimony has been adequately corroborated. *Id.* at 1196. "Corroborating evidence means nothing more than evidence that tends to strengthen or confirm other evidence already given." *Black's Law Dictionary* 414 (Rev. 4th ed. 1968). s*ee also Corona Cord Tire Co. v. Dovan Chem. Co.*, 276 U.S. 358, 381 (1928) (business records including record of shipment and shipping order); *Kiva Corp. v. Baker Oil Tools, Inc.*, 412 F.2d 546, 551-52 (5th Cir.) (job tickets prepared by affiant and his employer), *cert. denied*, 396 U.S. 927 (1969); *Rolls-Royce, Ltd. v. GTE Valeron Corp.*, 625 F. Supp. 343, 353-54 (E.D. Mich. 1985) ("[T]he law requires that there be some contemporaneous . . . physical evidence to establish the reduction to practice within the required time period . . . ."), *aff'd*, 800 F.2d 1101 (Fed. Cir. 1986).

In this case, Respondents presented ample evidence and testimony to corroborate the affidavits and declarations it submitted. This uncontroverted showing included documentary evidence of two processes identical to that claimed by Petitioner in use as early as 1981. (A150; A361) It included descriptions of the successful remediation of volatile contaminants through the same processes during 1982. (A136; A167-85; A 360-71) And it included testimony and evidence of the prior use of the same process by parties other than the affiants and declarants attacked by the Petition. (A211-17; A1604-68) This showing not suprisingly created an abiding conviction on the part of the District Court that public knowledge and use of the Claim 8 process

before it was "invented" by Petitioner had been established as a matter of law.

B. As a Matter of Law, Claim 8 is Invalid Under 35 U.S.C. § 103 as Obvious

Independent of its invalidity under 35 U.S.C. § 102, Claim 8 is invalid under 35 U.S.C. § 103. The United States patent system also does not allow the patenting of obvious improvements in the state of the art. The requirement of nonobviousness, codified in 35 U.S.C. § 103, rejects as unpatentable "insignificant variations and innovations of a commonplace sort." *Graham v. John Deere Co.*, 383 U.S. 1, 16 (1966). Because patent rights limit free competition, protection of the public interest in the free enterprise system requires that patents with obvious subject matter be declared invalid. *See Lear, Inc. v. Adkins*, 395 U.S. 653, 670 (1969); *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 330-31 (1945).

The determination of obviousness is a question of law. *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 716 (Fed. Cir. 1991). Applying this test, the District Court concluded that prior art, including the work of Duane Knopik, the ORS Soil Vent System described by Paul Yaniga, and the Exxon East Meadows system, taught the use of vacuum to induce air flow through contaminated soil in the vadose zone to volatilize liquid contaminants as described in Claim 8. In reaching this conclusion, the District Court had before it testimony explaining the scientific principles governing the volatilization of contaminants by air flowing through the soil. (A206-220) The same scientific principles are inherent in the volatilization of subterranean contaminants by air flow as taught by each of the foregoing prior art systems. The remaining elements of Claim 8 pertaining to well construction were known to those skilled in the art and

would have been obvious to use in a vacuum extraction well. (A136-139; A358-359; A217-218; A632-633; A193-194). Accordingly, the District Court correctly concluded that the combination of all of the elements disclosed by Claim 8 was taught by the prior art and would have been obvious to a person of ordinary skill in the art at the time the claimed invention was made.

C. The Courts Below Correctly Determined that Respondents' Process Does Not Infringe Claim 8 Because it is the Same as Processes Known and Publicly Used Before Petitioner's Process Was Conceived

The District Court correctly determined that Petitioner failed to carry his burden of proving infringement. To establish literal infringement of Claim 8, Petitioner must prove that every element of Claim 8 is used in Respondents' Process. *Becton Dickinson & Co. v. C.R. Bard, Inc.*, 922 F.2d 792, 796 (Fed Cir. 1990); *Corning Glass Works v. Sumitomo Elec. USA, Inc.*, 868 F.2d 1251, 1259 (Fed. Cir. 1989). To obtain summary judgment, therefore, Respondents need only demonstrate Petitioner's inability to prove a single element of his case. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1577 (Fed. Cir. 1989).

The District Court correctly concluded that the prior art process used by Respondents was no different from the processes reflected in the prior art. Respondent established that its process drew air through the soil, thereby causing liquid contaminants in the soil to evaporate:

> Movement of fresh air through the soil vented preformed vapors of the contaminant, disturbing both the equilibrium existing between vapor and liquid contaminants, and

> thus allowing more liquid contaminant to evaporate. As the flow of air continued, it removed the new vapors, which in turn resulted in the removal of additional liquid.

(A503)

At least one of the processes used by witnesses practicing prior art worked exactly the same way: "[T]he soil venting technology applies a vacuum to an extraction well to pull air through contaminated ground, thereby causing the liquid contaminants trapped in the soil to vaporize." (A135) Likewise, the process used by another of the parties' competitors worked by "drawing air through the soil, causing the trapped liquid hydrocarbon to vaporize." (A356-357) (quotation omitted). Respondents' soil venting process is therefore exactly the same as prior art processes known and used before Petitioner and his coinventor ever met. Thus, if Petitioner's argument were correct that the prior art processes were different from the process described in Claim 8, the Respondents' use of the prior art processes cannot infringe Claim 8.

Petitioner cannot have it both ways. Either Claim 8 describes a process that was previously used by others, in which case Claim 8 is invalid, or Claim 8 describes some process different from that previously used by others, in which case Respondents' process cannot infringe. In no case can Petitioner's patent prevent others from using a process that was known and used in the prior art. Thus, even if Claim 8 were valid, the District Court and Court of Appeals correctly entered and upheld summary judgment because Respondents used a prior art process at the single site cleanup charged to be an infringement.

Petitioner's tortured characterization of the oral argument before the Court of Appeals cannot change this result. In oral argument, counsel for Respondents noted that both Petitioner's and Respondents' processes leave nonvolatile

"fractions of the contaminant" at the site of a cleanup. Page 20 of the Petition in turn acknowledges that Petitioner's process fails to remove "a few parts [of contaminant] per billion of soil." The parties thus agree on the self-evident proposition that neither process--however effective it may be--removes *every* atom making up *every* molecule of *every* hydrocarbon contaminant that may be found at a particular site. Petitioner's suggestion that the wholly semantic distinction between the parties' phrasing of the same point is the proper subject for a petition for certiorari strains the limits of responsible advocacy.

CONCLUSION

To the extent that the Petition raises issues not resolved by the courts below, this Court is an inappropriate forum for their review. As to the merits of Petitioner's claims of infringement, the courts below applied well-established legal principles to undisputed facts to reach a result that was not only correct, but routine. Respondents therefore request that this Court deny the Petition.

Respectfully submitted this 22d day of January, 1996,

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